

REMARKS

A. The Section 112 Rejections and Objections to claims 1 and 18

The Applicants appreciate the Examiner's withdrawal of the 35 U.S.C. §112, second paragraph, rejections.

B. The Claim Amendments

Applicant has amended the independent claims in order to clarify them for the Examiner. For example, the phrase "speech-based" grammar has been added. As set forth below (see the discussion regarding the rejections of claims 6, 7 and 25), the Applicant does not feel this phrase needs to be added in order for the claims to be patentable over the references cited by the Examiner. Nonetheless, if it will expedite prosecution and allowance of the claims the Applicant will agree to these amendments. If the Examiner takes the position that these changes raise new issues, the Applicant will withdraw the amendments and appeal the Examiner's decision based on the unamended claims.

C. The Section 102 Rejections

Claims 1-15, 17-32 and 34 were rejected under 35 U.S.C. §102(e) as being anticipated by newly cited U.S. Patent No. 5,719,921 to Vysotsky et. al ("Vysotsky"). Applicant respectfully disagrees and traverses these rejections for at least the following reasons.

(i) Claims 1-15, 17-32 and 34

Initially, the Applicant notes that she is somewhat confused by the Examiner's position. As set forth in the independent claims, the present inventions are directed at methods and systems for permitting a subscriber to perform an action (i.e., feature) available on a communications network using a spoken utterance that includes an "always connected state" in which a feature may be accessed *even when a call is not in progress*.

In the Office Action the Examiner appears to take the position that Vysotsky discloses such a feature. However, this is clearly not the case.

Throughout Vysotsky reference is made to a “call” that is in progress. For example, Vysotsky states: “The present invention has the advantage of permitting a customer to place a call by speaking a person’s name which serves as a destination identifier without having to speak an additional command...” (underlining added). In sum, Vysotsky’s speech recognition system allows a telephone number of a party to be dialed without entering the number; just by saying the name of the party/person. To initiate its speech recognition features, however, a call must be initiated. (see column 2, lines 49-56; “In the event that only a speaker dependent name is recognized, a call is placed to the phone number associated with the recognized name in the customer’s personal directory. In this manner, a customer can place a call by simply speaking a name”; and see column 3, lines 35-40, “Accordingly, the method and apparatus of the present invention permits a user to place a call by speaking a name without the need to first speak a steering word”; yet further, see column 4, lines 11-15, “Upon receiving the beep, the customer is expected to speak in order to, e.g., place a call”.

As far as the Applicant can tell, Vysotsky is specifically aimed at the placement of a call using speech recognition. There appears to be no disclosure or suggestion that its features can be used without placing a call.

(ii) Claims 6, 7 and 25

In these dependent claims, spoken utterances are recognized by comparing the utterances to a predetermined grammar, where the grammar may be in multiple languages. In the Office Action the Examiner takes the position that Vysotsky’s “programming languages” are grammars.

The Applicant is unaware of any basis for such a statement. Simply stated, there is absolutely no basis for interpreting the word “grammar” in claims 6, 7 and 25 (and elsewhere) as being a programming language. As the specification points out, the word grammar denotes a spoken dialect, not computer code:

“Males, females, children, and people from different backgrounds, parts of a country, ethnicity, etc. pronounce words differently”, page 23, lines 1-2. The Applicant notes that although Examiners are instructed to interpret claims broadly, such interpretations must be consistent with the specification, *In re Hyatt*, 211 F.3d 1367,1372 (Fed. Cir. 2000). In this instance, interpreting “grammar” to mean a programming language is inconsistent with the specification.

Because Vysotsky does not disclose each and every feature of the present invention, it cannot be a basis for anticipation under § 102(e).

Accordingly, Applicant respectfully requests withdrawal of the rejections and allowance of claims 1-15, 17-32 and 34.

D. The Issuance of a Final Rejection Is Premature: The Finality Should be Withdrawn

In the Office Action the Examiner cites a new reference, Vysotsky and makes the action final on the basis that “Applicant’s amendment necessitated the new grounds of rejection” (page 10 of Office Action). It is respectfully submitted that this is in error.

Applicant’s amendment was directed to §112 informalities. More specifically, Applicant amended claims 1 and 18 to replace the words “call flow step” with the words –system state--. Neither of these phrases relate to patentability issues involving the newly cited reference, Vysotsky, nor the previously cited reference, Beith et al. addressed in Applicant’s previous response.

In sum, the Applicant’s previous response did not necessitate the new grounds of rejection cited by the Examiner. Instead, it is respectfully submitted that is an attempt by the Examiner to impermissibly and prematurely cutoff prosecution.

The Applicant respectfully requests that the finality of the present Office action be withdrawn.

E. Entry of Request for Reconsideration

Entry of this Request for Reconsideration (“Request”) is solicited because the Request: (a) places the application in condition for allowance for the reasons discussed herein; (b) does not raise any new

issues regarding further search and/or consideration; (c) does not present any additional claims without canceling the corresponding number of finally rejected claims; and (d) places the application in better form for appeal, if an appeal is necessary.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John E. Curtin at the telephone number listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 50-3777 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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By

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